

Appl. No. 09/655,755
Amdt. Dated June 7, 2004
Reply to Office action of March 10, 2004
Attorney Docket No. P12103-US1
EUS/J/P/04-2018

REMARKS/ARGUMENTS

1.) Allowable Subject Matter

The Examiner objected to claims 5 and 15 as being dependent upon rejected base claims, but indicated such claims would be allowable if rewritten in independent form, including all of the limitations of their respective base claims (Claims 1 and 13) and any intervening claims. The Applicant thanks the Examiner for the indication of allowable subject matter. Whereas the Applicant believes claims 1 and 13 recite allowable subject matter, however, the Applicant declines to rewrite claims 5 and 15 in independent form.

2.) Claim Rejections-35 U.S.C. §112

The Examiner rejected claims 11 and 21 as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as the invention. The Applicant traverses the rejection.

The Examiner stated that there is insufficient antecedent basis for the limitation "the overlap-add method" recited in claims 11 and 21. In a preliminary amendment filed with the application, however, the word "the" preceding "overlap-add method" was replaced with the word "an." The limitation "using an overlap-add method" modifies the prior limitation of "performing the convolution step in the frequency domain." Accordingly, as a new limitation, there is no lack of antecedent basis. The Applicant, therefore, respectfully requests that the Examiner withdraw the rejection.

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3.) Claim Rejections – 35 U.S.C. §102(e)

The Examiner rejected claims 1-4, 6-14, and 16-22 as being anticipated by United States Patent No. 6,459,914 B1 issued to Gustafsson *et al.* The Applicant traverses the rejection.

For Gustafsson to anticipate the claimed invention, it must not merely approximate or be almost the same as the invention, but there must be an identity of invention between it and the claim. Anticipation requires the presence in the Gustafsson disclosure of all elements of the claimed invention arranged as in the claim. The claim limitations which must be met are those set forth in each element, and such a limitation cannot be met by an element in Gustafsson that performs a different function, even though it may be part of a device embodying the same general overall concept. See, *RCA Corp. v. Applied Digital Data Sys., Inc.* 221 USPQ 385, 389 n.5 (Fed. Cir. 1984).

Claim 1 recites:

1. A method of designing a digital filter, including the steps of
determining a real-valued discrete-frequency representation of a
desired full length digital filter;
transforming said discrete-frequency representation into a
corresponding discrete-time representation;
circularly shifting said discrete-time representation; and
applying a shortening window to said discrete-time representation
to produce a zero-padded reduced length filter.

Each of the limitations of claim 1 recite functionality that is dependent upon prior claim limitations. Although claim 1 contain terms which the Examiner has related to similar terms distributed throughout Gustafsson, the functionality embodied by the limitations of the claim, taken as a whole, is not disclosed by Gustafsson. This is apparent by noting that the Examiner's references to portions of Gustafsson for each claim limitation are

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→ not ordered sequentially, but are taken from random portions of Gustafsson. For example, with respect to the first limitation (determining a real-valued discrete-frequency representation of a desired full length digital filter), the Examiner makes reference to column 6, lines 15-30 of Gustafsson; with respect to the second limitation (transforming said discrete-frequency representation into a corresponding discrete-time representation), the Examiner makes reference to column 8, lines 16-24 of Gustafsson; with respect to the third limitation (circularly shifting said discrete-time representation), the Examiner makes reference to column 7, line 55 to column 8, line 25 of Gustafsson; and, with respect to the fourth limitation (applying a shortening window to said discrete-time representation to produce a zero-padded reduced length filter), the Examiner makes reference to column 8, lines 18-33 of Gustafsson; i.e., the Examiner jumps from column 6 to column 8, back to column 7, and then forward to column 8. Accordingly, Gustafsson is obviously not disclosing the invention claimed by Applicant, which depends upon a specific ordering of the performance of claim limitations.

The Examiner has based the rejection on apparently similar terms used in Gustafsson, without taking into consideration the invention as a whole. As noted previously, there must be an identity of invention, which requires the presence in Gustafsson of all elements of the claimed invention arranged as in the claim. Whereas the Examiner has failed to consider the functionality of each claim limitation, and the relation of each limitation to the invention as a whole, the Examiner has not established that Gustafsson anticipates claim 1. Accordingly, Gustafsson fails to anticipate claim 1.

Whereas claims 7, 13 and 17 recites limitations analogous to claim 1, those claims are also not anticipated by Gustafsson. Furthermore, whereas claims 2-4 and 6

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are dependent from claim 1; claims 8-12 are dependent from claim 7, claims 14 and 16 are dependent from claim 13, and claims 18-22 are dependent from claim 17, and include the limitations of their respective base claims, those claims are also not anticipated by Gustafsson. The Applicants, therefore, respectfully request that the Examiner withdraw the rejection of claims 1-4, 6-14 and 16-22 as being anticipated by Gustafsson.

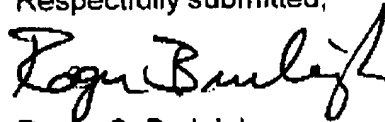
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CONCLUSION

In view of the foregoing remarks, the Applicant believes all of the claims currently pending in the Application to be in a condition for allowance. The Applicant, therefore, respectfully requests that the Examiner withdraw all rejections and issue a Notice of Allowance for claims 1-22.

The Applicant requests a telephonic interview if the Examiner has any questions or requires any additional information that would further or expedite the prosecution of the Application.

Respectfully submitted,



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